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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,706	05/29/2001	Takanori Yamazaki	1341.1094	5744

21171 7590 06/01/2005

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EXAMINER

O CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,706

Applicant(s)

Yamazaki

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 8, 2004 and March 17, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5, 7, and 11 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 7, and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 29, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment filed by applicant on March 17, 2005 and to the arguments filed by applicant on December 8, 2004, both in reply to the first Office action on the merits, mailed July 14, 2004.

2. The amendment of claims 1, 3, 5, and 7, the cancellation of claims 2, 4, and 6, and the addition of claim 11 by applicant, in the reply filed March 17, 2005, are hereby acknowledged.

Claim Rejections - 35 USC § 101

3. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 3, 5, 7, and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 3, 5, 7, and 11 are drawn to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea without producing any “useful, concrete, and tangible result.” *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

Additionally, method claims that fail to require the use of any technology, such as claims 1, 3, 5, 7, and 11, are considered non-statutory under § 101, for failing to fall within the technological arts. Claims must be tied to a technological art. To overcome this aspect of the rejection, a positive limitation in the body of the claim is required to recite the use of some technology, such as either a computer, *per se*, or else some other computer element that would inherently and necessarily require a computer (e.g., a website), or else some other aspect or element of technology.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 5, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boardman et al. (US 6,456,986).

Boardman et al. disclose a support fee setting method comprising multiple grades of service for users (each user inherently having a userid in order to be stored in a user database), obtaining the grade of a user by referring to a user information database, and setting a support fee based on the grade of the user, but Boardman et al. specifically disclose neither a point system

with a point-to-grade conversion table, nor including the actual cost for responding to an inquiry from a user in the determination of the support fee.

However, a point system with a point-to-grade conversion table, and basing a fee on an actual cost, are two well known, hence obvious, elements to include in any method of setting a fee/pricing structure, and official notice to that effect is hereby taken. For example, each “point” could be just one minute of support time, each “grade” could be a level of minutes (i.e., up to 30 minutes, up to 60 minutes, etc.), and including the “actual cost” could be as simple as entitling a user of a particular grade to a particular percentage level of discount (e.g, additional, overage minutes costing more per minute for a 30-minute-plan customer than for a 60-minute-plan customer).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Boardman et al. so as to use a point system with a point-to-grade conversion table, and to include the actual cost for responding to an inquiry from a user in the determination of the support fee, as is well known to do, in order to increase revenue by enticing customers into purchasing excess support coverage in order to avoid shortfalls, similar to the pricing scheme/model commonly used with mobile phones.

Regarding claims 3, 5, and 7, all of the recited features are found directly in the disclosed method of Boardman et al., or they are inherently present in the modification described above, or they are of such a minor difference that their inclusion would have been self-evident/obvious to one of ordinary skill in the art, at the time of the invention, simply as a matter of design choice, since their inclusion could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Response to Arguments

7. Applicant's arguments filed December 8, 2004 have been fully considered but they are not persuasive.

8. Regarding the argument that the examiner has failed to provide a reference as evidence of what the examiner has found to be "well known" prior art, the argument has been disregarded as merely spurious, since challenging the existence of well known prior art by merely arguing that the fact is not supported by a reference, without stating for the record that the examiner is wrong or that applicant is without knowledge of the prior art teaching, does not constitute a *proper* traversal of the finding(s).

To rise to the level of a *proper* traverse necessitates that applicant address/traverse the specific example(s) of the well known prior art cited/offered by the examiner, not merely restate the recited feature of the claim and generally state simply that the recited feature is unknown. For example, simply stating that claim 1 recites "a point system with a point-to-grade conversion table," and that "such a feature is not well known" is not a proper traverse because it utterly fails to address the example of such a feature cited by the examiner, that being a cell-phone plan with minutes being the "points" and different plans with various levels of minutes (30, 60, etc.), the per-minute rate becoming more economical with increasing minutes/points.

To the extent applicant is perhaps considering that "minutes" are not "points," thus a recitation of "points" would patentably distinguish the instant invention over prior art comprising "minutes," such is not the case, since it is well settled that the disclosure in a reference must show

the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Whereas applicant has now failed to *seasonably* provide any *proper* traverse to the examiner's stated positions as to what is well known prior art, and, as any further traversal (proper or not) would no longer be considered seasonable, the object of the well known statement is therefore now deemed and considered henceforth to be admitted prior art. See MPEP § 2144.03.

9. Regarding the arguments with respect to 35 U.S.C. 101, note that a mere recitation of a "data processing system" does not *necessarily require* a electrical digital computer.

10. Regarding the argument that Boardman et al. is directed to a system for charging users for making telephone calls, not a system for providing "support coverage," providing support coverage by means of telephone calls is ubiquitous in the art. Moreover, again, as noted above, it is well settled that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

11. Regarding the argument that simply because one *could* combine or modify references does not *necessarily* mean that such a combination or modification can *automatically* be considered obvious, applicant is correct. However, the main test for obviousness in such a case

is whether or not one of ordinary skill in the art would be readily and easily able to make the proposed combination or modification, with neither undue experimentation, nor risk of unexpected results. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379.

The instant invention is considered obvious because the proposed combinations/modifications, in accordance with this test, could indeed all be made readily and easily by one of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to the disclosure.

13. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(571) 272-6788**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

May 26, 2005



Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627